

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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3711

In re Application of: Benjamin J. Kwitek

Serial No.: 09/173,445

Group Art Unit: 3711

Filed : 10/16/98

Examiner: Blau

Title : GOLF GRIP



Commissioner of Patents & Trademarks
Washington, D.C. 20231

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION -- 37 CFR 192)

1. Transmittal herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on 12/18/2000.

NOTE: "The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate." 37 CFR 1.192 [emphasis added].

2. STATUS OF APPLICANT

This application is on behalf of

___ other than a small entity

X small entity

verified statement:

___ attached

X already filed

RECEIVED
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TECHNOLOGY CENTER R3700

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

X small entity \$155.00

___ other than a small entity \$310.00

Appeal Brief fee due \$ 155.00

4. EXTENSION OF TERM

NOTE: The time periods set forth in 37 CFR 1.192(a) are subject to the provision of § 1.136 for patent applications 37 CFR 1.191(d). Also see Notice of November 5, 1985 (1060 O.G. 27).

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

(complete (a) or (b) as applicable)

- (a) _____ Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

	<u>Extension</u> <u>(months)</u>	<u>Fee for other than</u> <u>small entity</u>	<u>Fee for</u> <u>small entity</u>
_____	one month	\$110.00	\$ 55.00
_____	two months	\$390.00	\$195.00
_____	three months	\$890.00	\$445.00
_____	four months	\$1390.00	\$695.00

Fee \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- _____ An extension for _____ months has already been secured and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

or

- (b) X _____ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$ 155.00
Extension fee (if any) \$ _____

TOTAL FEE DUE \$ 155.00

6. FEE PAYMENT

X _____ Attached is a check in the sum of \$ 155.00 .
_____ Charge Account No. 01-2221 the sum of \$ _____ .
A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

NOTE: If there is a deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to change the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

X If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 01-2221.

AND/OR

X If any additional fee for claims is required, charge Account No. 01-2221.

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SIGNATURE OF ATTORNEY

Howard N. Flaxman
Type or print name of attorney

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Docket No. KWI-001



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APPEAL BRIEF

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Sir:

REAL PARTY IN INTEREST

Benjamin J. Kwitek is the real party interest in the above referenced patent application.

RELATED APPEALS AND INTERFERENCES

Neither Appellant's representative nor Appellant is aware of any related appeals and/or interferences affected by or having a bearing on the Board's decision in the pending appeal.

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STATUS OF CLAIMS

Claims 1, 3, 7-10, 14 and 21-29 are currently pending in the above referenced application. Appellant accordingly Appeals the Examiner's Final Rejection of claims 1, 3, 7-10, 14 and 21-29 which is as follows:

1. Claims 1, 3, 7-10 and 14 and 21-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,322,290 to Minami ("Minami"), in view of U.S. Patent No. 5,555,484 to Moore, III et al. ("Moore") and U.S. Patent No. 5,730,699 to Huang ("Huang").

STATUS OF AMENDMENTS

Appellant has filed an Amendment After Final Rejection concurrently herewith. The Amendment After Final Rejection relates to the dependency of claim 7 and sets out to remedy the rejection under 35 U.S.C. § 112, 2nd paragraph. Since the Amendment does not raise new issues, Appellant presumes the Amendment After Final Rejection will be entered as placing the application in better condition for appeal.

SUMMARY OF THE INVENTION

The golf grip 110 is designed with a responsive and relatively viscoelastic hand surface 112. The viscoelastic hand surface 112 provides golfers with a soft and individually conforming hand surface. (Page 7, lines 9-13)

The hand surface 112 of the present grip is an ultra-soft material. This also endows the product with an inherent tactile feel. The grip, as described herein, provides a tacky surface, essential and beneficial for gripping. The ultra-soft hand surface can be measured in terms of hardness by the Shore A Durometer Test. The present grips have durometers in this scale

between approximately 2 and 40. (Page 7, lines 18-24)

The golf grip 110 includes a shell 114 shaped and dimensioned to fit about the proximal end 16 of a golf club shaft 18. As such, the shell 114 includes an inner surface shaped and dimensioned to fit about the golf club shaft 18. The outer surface 34 of the shell 114 is shaped and dimensioned to receive the viscoelastic hand surface 112. (Page 8, lines 1-8.) The shell 114 is preferably constructed from a variety of soft elastomers, such as, rubber or synthetic rubber-like materials. (Page 8, lines 13-16)

The shell 114 includes a central section 120 about which the viscoelastic hand surface 112 is positioned. The proximal end 122 and distal end 124 of the shell 114 are respectively provided with lips 126, 128 circumferentially extending about the shell 114. The lips 126, 128 are shaped and dimensioned to retain the viscoelastic hand surface 112 about the central section 120 of the shell 114. (Page 10, lines 1-9)

The viscoelastic hand surface 112 is a viscous liquid material 136 contained in an elastomeric bag 138. The viscous liquid 136 is preferably a silicone gel or oil and the elastomeric bag 138 is preferably a silicone sheet or a thermoplastic elastomer. (Page 10, lines 10-14)

The viscoelastic hand surface 112 is adhered to the central section 120 of the shell 114 with an adhesive. The attachment could also be accomplished by compressing both ends of the elastomeric bag 138 at the proximal and distal lips 126, 128 with a chamber and gasket system. (Page 10, lines 18-22)

The present golf grip 110 is designed for placement about the proximal end of the golf club shaft 18 in much the same manner that conventional golf grips are placed about the proximal end of a golf club shaft. As such, the present golf grip 110 may be used as a replacement grip for worn grips or grips placed upon a golf club during the manufacture of the golf club. (Page 11, lines 1-7)

In accordance with the preferred embodiments of the present invention, the soft polymer material forming the hand surface 112 is approximately $1/16''$ - $1/4''$ thick and the elastomeric shell 114 is less than $1/4''$ thick. The present grip 110 will, therefore, have substantially the same dimensions as conventional golf grips. (Page 11, lines 8-13)

The provision of a responsive viscoelastic polymer hand surface provides golfers with a soft and individually conforming hand surface. In this way, the present grips are designed to enhance the feel of the golf club, and, thereby, improve the golfer's ability to strike a golf ball. A soft grip surface prompts the golfer to use a softer touch in putting and helps to avoid excessive squeezing on other clubs. The soft viscoelastic hand surface also reduces hand fatigue associated with gripping a hard hand surface. In addition, the use of an elastomeric shell with a responsive viscoelastic polymer material encased therein makes the present golf grip easy to manufacture and place upon the proximal end of a golf club shaft for use by a golfer. (Page 13, lines 7-19)

ISSUES

1. Whether claims 1, 3, 7-10, 14 and 21-29 are unpatentable under 35 U.S.C. § 103(a) based upon the disclosure of Minami, in view of Huang and Moore.

GROUPING OF THE CLAIMS

Claims 1, 3, 7-10 and 21-29 do not stand or fall together.

Appellant's claims 1, 3, 7-10 and 14 stand or fall together.

Appellant's claims 21-27 stand or fall together.

Appellant's claims 28 and 29 stand or fall together. However, since claims 28 and 29 are respectively dependent upon independent claims 21 and 1, these claims would be considered allowable if the respective independent claims were separately determined to be allowable over the prior art of record.

ARGUMENTS

I. CLAIMS 1, 3, 7 AND 10-14 ARE NOT OBVIOUS UNDER 35 U.S.C. § 103(A) BASED UPON THE DISCLOSURE OF MINAMI IN VIEW OF HUANG AND MOORE.

Claim 1 defines a viscoelastic hand surface having a thickness. The viscoelastic hand surface is secured about the outer surface of a tubular shell, wherein the viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag. The tubular shell includes a shell having a first end and a second end. The tubular shell also includes an outwardly extending first lip adjacent the first end of the tubular shell and an outwardly extending second lip adjacent the second end of the tubular shell.

The first and second lips define a central section within which the viscoelastic hand surface is positioned. The central section has a depth as defined by the first and second lips which is substantially the same as the thickness of the viscoelastic hand surface such that the first and second lips retain the viscoelastic hand surface in position on the tubular shell.

The Examiner indicates that Minami discloses a golf club grip having an outer surface of low elasticity and high viscosity. The Examiner further states that Huang discloses a golf handle grip having a resilient rubber-like sleeve with a cap and guide cylinder. In addition, the Examiner states that Moore discloses a tennis grip formed with a viscoelastic material contained within a casing. The Examiner then argues that it would in fact be obvious to modify Minami based up on the disclosures of Moore and Huang in meeting the claims of the present application.

It is, however, Appellant's opinion that it would not have been obvious to modify Minami based upon the disclosures of Huang and Moore to meet the outstanding claims. Specifically, while Huang does disclose the inclusion of a cap 62 and guide cylinder 64, Huang makes no suggestion as to the necessary depth for the cap 62 and guide cylinder 64. Huang's lack of disclosure relating to the depth of the cap 62 and the guide cylinder 64 is dictated by the fact that Huang makes no provision for utilizing upper and lower lips (or in the case of Huang; the cap 62 and guide cylinder 64) as a mechanism for retaining a viscoelastic material therebetween and any consideration of depth is irrelevant. Similarly, Moore provides no suggestion for retaining the disclosed grip surface between upper and lower lips in the claimed manner.

The Examiner counters Appellant's arguments regarding the unobviousness of the proposed combination by stating that he considers Minami to disclose the broad concept of teaching a two-layer grip with the outer layer being of high viscosity, Moore to disclose a suitable high viscosity material, and Huang to disclose a shell having circumferential lips and a central section defined by the first and second lips (the cap 62 and guide cylinder 64 previously discussed). The Examiner takes these three very different features and improperly concludes that, because they all relate to golf grips, it would have been obvious to utilize the features thereof in creating a grip such as that claimed by Appellant.

In contrast to the assertions presented by the Examiner, the golf grips disclosed in the cited prior art consider very different problems and the teachings therein are not appropriate

for modifying the other cited patents. Minami does disclose a two-piece golf grip having an outer surface with a high viscosity and Huang does disclose the inclusion of a cap 62 and guide cylinder 64. However, Huang is concerned with the fabrication of an injection molded grip and makes no disclosure relating to the necessary depth for these members in the event one were to incorporate a high viscosity grip member between the cap and guide cylinder as is suggested by the Examiner. In fact, nothing in the cited prior art suggests the necessity of providing lips for maintaining a high viscosity outer surface member upon an inner shell as is disclosed and claimed in the present application. (

It is, therefore, Appellant's opinion that there is no suggestion in the prior art for combining Huang and Moore to modify Minami to include upper and lower lips shaped and dimensioned to conform with the thickness of a viscoelastic surface positioned within the central portion thereof. While each of the broad statements regarding the respective teachings of Minami, Moore and Huang as suggested by the Examiner are true, they have no bearing on whether the proposed modification is in fact proper. That is, the broad statements regarding the teachings of Minami, Huang and Moore have no bearing on whether it would have been obvious to modify the disclosed grip of Minami based upon the disclosure of Huang to include the first and second lips which define a recess in which the viscoelastic hand surface may be readily positioned. They have no bearing because none of these references provide teachings which are relevant to the other prior art references. 2

The teachings of the cited prior art are very specific to the individual structures respectively disclosed by Minami, Huang and Moore, and provide no teachings applicable to the grips disclosed by the others. In fact, the only way one would look at Minami, Huang and Moore, and consider including lips to retain the viscoelastic hand surface disclosed by Moore, would be to look at the present disclosure for a suggestion of the combination. Moore discloses no need for retaining the viscoelastic hand surface on the grip he discloses, and Huang discloses no reason for including lips of a specific depth to retain a gripping surface therebetween. That is, nothing in either Huang, Moore or Minami discloses the need for providing first and second lips for maintaining a viscoelastic hand surface in position on an inner shell.

The Examiner has simply taken a piecemeal approach in finding each feature of the claimed invention and combined the teachings disregarding the fact there is no suggestion why one of ordinary skill in the art would ever combine the prior art to meet the pending claims. With this in mind, it is Appellant's opinion that the contention that it would have been obvious to modify Minami based upon the very different disclosures of Huang and Moore is improper and Appellant respectfully requests that the rejection be reversed.

II. CLAIMS 21-27 ARE NOT UNPATENTABLE UNDER 35 U.S.C. § 103(A) BASED UPON THE DISCLOSURES OF MINAMI IN VIEW OF HUANG AND MOORE.

Claim 21 is substantially similar to claim 1, but defines the relationship between the first and second lips and the viscoelastic hand surface by stating that “the first and second lips [are] shaped and dimensioned to retain the viscoelastic hand surface in position on the tubular shell”. As such, and with reference to the remarks presented above with regard to claims 1, 3, 7 and 10-14, it is Appellant’s position that the proposed modification of Minami based upon the disclosures of Moore and Huang is improper and relies upon impermissible hindsight.

Specifically, while Minami does disclose a golf club grip having an outer surface of low elasticity and high viscosity, Huang does disclose a golf grip having a resilient rubber-like sleeve with a cap and guide cylinder, and Moore does disclose a tennis grip formed with a viscoelastic material contained within a casing, none of these prior art references disclose or suggest the obviousness of combining these distinct features to meet the pending claims. While Huang does disclose the inclusion of a cap 62 and guide cylinder 64, Huang makes no suggestion as to the necessary depth for these members such that they would be capable of retaining a viscoelastic material therebetween. In addition, Huang makes no provision for utilizing upper and lower lips as a mechanism for retaining viscoelastic material therebetween. Finally, Moore provides no suggestion for retaining the disclosed grip surface in the claim manner.

For this reasons, as well as those discussed above with regard to claim 1, Appellant believes the rejection is improper and asks that it be reversed.

III. CLAIMS 28 AND 29 ARE NOT UNPATENTABLE UNDER 35 U.S.C. § 103(A) BASED UPON THE DISCLOSURE OF MINAMI IN VIEW OF HUANG AND MOORE.

Claims 28 and 29 are respectively dependent upon independent claims 21 and 1, and add further limitations defining that the viscoelastic hand surface has a thickness between approximately 1/16" and 1/4". Nothing in the prior art suggests the claimed range for the viscoelastic hand surface nor does anything in the prior art disclose or suggest lips which would be substantially equivalent in thickness to the viscoelastic hand surface.

The Examiner addresses this deficiency by simply stating, "Moore clearly discloses a thickness for sheets of this material in the ranges as claimed. Golfers have all sorts of needs from minimizing weight of a grip in order to lower a swing weight of a club to maximize and grip material to minimize damage to a player's hand when impacting a ball. These ranges are suitable ranges that can be selected by a golfer". Appellant finds it difficult to understand how such an argument supports the contention of obviousness proposed by the Examiner.

While each of the statements regarding the thickness of a gripping surface of a golf club are true, they have no bearing on the situation at issue. That is, they have no bearing on whether it would have obvious to modify the disclosed grip of Minami based upon the disclosure of Huang to include the claimed first and second lips which define a recess in which

the viscoelastic hand surface may be readily positioned. The only way one would look at Huang and consider including lips to retain the viscoelastic hand surface disclosed by Moore would be to look at the present disclosure for a suggestion of the combination.

That is, nothing in either Huang, Moore or Minami discloses the necessity of providing first and second lip for maintaining a viscoelastic hand surface having a thickness between approximately 1/16" and 1/4" on an inner shell.

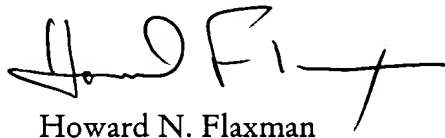
Once again, the contention that it would have been obvious to modify Minami based upon the very different disclosures of Huang and Moore is unsupported by the teachings provided therein and Appellant respectfully requests that the rejection of claims 28 and 29 be reversed.

IV. CONCLUSION

In conclusion, Appellant has now shown that the references cited in the Office Action neither disclose nor suggest the claimed grip. The claimed grip generally includes a viscoelastic hand surface secured about the outer surface of a tubular shell, the tubular shell having first and second lips which retain the viscoelastic hand surface on the tubular shell. The Examiner's continued assertions regarding the obviousness of combining diverse and distinct features relating to grips is wholly unsupported when one considers the lack of

suggestions in the prior art for modifying the disclosure of Minami as suggested by the Examiner. Therefore, it is respectfully requested that all of the outstanding rejections be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'H. N. Flaxman', with a long horizontal stroke extending to the right.

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Docket No. KWI-001

APPENDIX
CLAIMS ON APPEAL

1. A grip adapted for attachment to an implement including a handle, comprising:
a longitudinally extending tubular shell including an inner surface shaped and dimensioned for attachment to the handle of the implement and an outer surface; and
a viscoelastic hand surface having a thickness secured about the outer surface of the tubular shell, wherein the viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag; and wherein the tubular shell includes a first end and a second end, and the tubular shell includes an outwardly extending first lip adjacent the first end of the tubular shell and a outwardly extending second lip adjacent the second end of the tubular shell, the first and second lips defining a central section within which the viscoelastic hand surface is positioned, wherein the central section has a depth as defined by the first and second lips which is substantially the same as the thickness of the viscoelastic hand surface such that the first and second lips retain the viscoelastic hand surface in position on the tubular shell.
3. A grip according to claim 1, wherein the first lip extends about the circumference of the tubular shell adjacent the first end of the tubular shell and the second lip extends about the circumference of the tubular shell adjacent the second end of the tubular shell.

7. A grip according to claim 1, wherein the viscous liquid material is a silicone gel or silicone oil.
8. A grip according to claim 1, wherein the tubular shell is a soft elastomer.
9. A grip according to claim 1, wherein the grip is shaped and dimensioned for use as a golf club grip.
10. A grip according to claim 9, wherein the tubular shell is substantially cylindrical shaped with a slight taper.
14. The apparatus according to claim 13, wherein the workpiece has a longitudinal axis oriented perpendicular to a direction of blade travel during slicing, and further comprising workpiece guides for maintaining the longitudinal axis of the workpiece in a substantially perpendicular orientation to the direction of blade travel during slicing.

21. A grip adapted for attachment to an implement including a handle, comprising:
a longitudinally extending tubular shell including an inner surface shaped and dimensioned for attachment to the handle of the implement and an outer surface; and
a viscoelastic hand surface having a thickness secured about the outer surface of the tubular shell, wherein the viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag; and wherein the tubular shell includes a first end and a second end, and the tubular shell includes an outwardly extending first lip adjacent the first end of the tubular shell and a outwardly extending second lip adjacent the second end of the tubular shell, the first and second lips being shaped and dimensioned to retain the viscoelastic hand surface in position on the tubular shell.
22. A grip according to claim 21, wherein the first lip extends about the circumference of the tubular shell adjacent the first end of the tubular shell and the second lip extends about the circumference of the tubular shell adjacent the second end of the tubular shell.
23. A grip according to claim 21, wherein the viscoelastic liquid material is a silicone gel or silicone oil.
24. A grip according to claim 21, wherein the tubular shell is a soft elastomer.

25. A grip according to claim 21, wherein the grip is shaped and dimensioned for use as a golf club grip.
26. A grip according to claim 25, wherein the tubular shell is substantially cylindrical shaped with a slight taper.
27. A grip according to claim 25, wherein the tubular shell is a soft elastomer.
28. A grip according to claim 21, wherein the viscoelastic hand surface has a thickness between approximately 1/16" and 1/4".
29. A grip according to claim 1, wherein the viscoelastic hand surface has a thickness between approximately 1/16" and 1/4".